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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,514	03/01/2004	Henri V. Azibert	CTH-302	2753
959	7590	01/05/2006	EXAMINER	
LAHIVE & COCKFIELD, LLP.			LEE, GILBERT Y	
28 STATE STREET			ART UNIT	
BOSTON, MA 02109			PAPER NUMBER	

3673

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/791,514

**Applicant(s)**

AZIBERT, HENRI V.

**Examiner**

Gilbert Y. Lee

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 3, 9-17, 25-28, 30, 31, 34, 36 and 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8, 18-24, 29, 32, 33, and 37-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/1/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 3,9-17,25-28,30,31,34,36 and 43-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/12/05.

### ***Priority***

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/450797, fails to provide adequate support or enablement in the manner provided by the first paragraph

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of 35 U.S.C. 112 for one or more claims of this application. In Application No. 60/450797, Fig. 5 is not disclosed. In the current application, Fig. 5 has been added and is considered new subject matter.

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the carrier element in claim 5; a housing in claim 8; a contact areas in claims 20,22 40, and 22; a means for introducing a barrier fluid to the seal in claim 23; a shuttle stop in claim 29; and first and second piston area in claims 18 and 38 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 27001. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

1. The abstract of the disclosure is objected to because it exceeds the maximum of 150 words. Correction is required. See MPEP § 608.01(b).

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2. The disclosure is objected to because of the following informalities: Page 7, Line 20 "sued" should be changed to "used" and Page 17, Line 27 "5400" should be changed to "54000".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 32, 33, and 37-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claims 32, 33, and 37-42 are ambiguously constructed and indeterminate in scope because they purport to claim both an apparatus and method of using or practicing the apparatus in a single claim. It is noted that the dependent claims of claim 32 refer to a method; if a method is desired, the preamble of claim 32 should start with "A method of ...".

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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1. Claims 32, 33, and 37-42 are rejected under 35 U.S.C. 101 because they improperly embrace both product or machine and process. The language of 35 U.S.C. 101 sets forth statutory classes of invention in alternative only. See Ex parte Lyell, 17 USPQ2d 1549.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1,2,4-8,18-24, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Azibert et al. (US Patent No. 6,935,632)

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, the Azibert et al. reference discloses a mechanical seal (100) comprising: a gland (130); a rotary seal ring (150) and a stationary seal ring (160); and a shuttle member (170).

Regarding claim 2, the Azibert et al. reference does not specifically disclose that the shuttle member (170) generates a biasing force, however, it is inherent that the shuttle member will generate a biasing force because the shuttle member will move between positions and abut other elements causing a biasing force.

Regarding claim 4, the Azibert et al. reference discloses the shuttle member (170) disposed adjacent the stationary seal ring (Fig. 9).

Regarding claim 5, the Azibert et al. reference discloses the shuttle member comprising a carrier having a first end portion and a second end portion (Fig. 9).

Regarding claim 6, the Azibert et al. reference discloses the carrier element comprising a groove (groove in which element 175 is situated) for seating a sealing element.

Regarding claim 7, the Azibert et al. reference discloses the sealing element being an O-ring (175).

Regarding claim 8, the Azibert et al. reference discloses a housing having one or more grooves (Fig. 9).

Regarding claims 18-22, the Azibert et al. reference, as best understood from the drawings, discloses the mechanical seal further comprising: a first and second piston area (Fig. 9).

Regarding claim 23, the Azibert et al. reference, as best understood from the drawings, discloses the gland comprising a means for introducing a barrier fluid to the seal (Fig. 9).



Regarding claim 24, the Azibert et al. reference discloses a second pair of seal member (Fig. 9) including a rotary seal ring (151) and a stationary ring (161).

Regarding claim 29, the Azibert et al. reference, as best understood from the drawings, discloses the shuttle member abutting the shuttle stop (Fig. 9). Note that in one position, the upwardly extending portion of element 160 will act as a shuttle stop or the downwardly extending portion of element 190 will act as a shuttle stop for another position.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Attenasio et al. (US Patent No. 5,489,105), Clark et al. (US Patent No. 5,913,520), and Carmody (US Patent No. 5,354,070)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilbert Y. Lee whose telephone number is 571-272-5894. The examiner can normally be reached on 8:00 - 4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Suzanne L. Barrett can be reached on (571)272-7053. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GL

12/22/2005

Suzanne Barrett

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A handwritten signature in black ink, appearing to be 'Suzanne Barrett', written over a horizontal line.